REMARKS

Claims 1, 2, 4-26, and 29-34 were pending in this application.

Claims 1, 2, 4-26, and 29-34 have been rejected.

Claims 1, 8, 13, 18, 25, 29, and 31 have been amended as shown above.

Claims 1, 2, 4-26, and 29-34 remain pending in this application.

Reconsideration and full allowance of Claims 1, 2, 4-26, and 29-34 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4, 6-8, 10-12, 18, 20, 21, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,483,278 to Strubbe et al. ("*Strubbe*") in view of U.S. Patent No. 5,945,988 to Williams et al. ("*Williams*") and U.S. Patent No. 5,7571,282 to Girard et al. ("*Girard*"). The Office Action rejects Claims 5, 9, 19, and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, *Williams*, and *Girard* in further view of U.S. Patent No. 5,798,785 to Hendricks et al. ("*Hendricks*"). The Office Action rejects Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, *Williams*, and *Girard* in further view of U.S. Patent No. 5,959,688 to Schein et al. ("*Schein*"). The Office Action rejects Claim 26 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, *Williams*, and *Schein* in further view of *Hendricks*. The Office Action rejects Claims 13-17, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe* and *Hendricks* in further view of *Girard*. The Office Action rejects Claims 31 and 32 under 35

U.S.C. § 103(a) as being unpatentable over *Strubbe* in view of *Girard*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

Regarding Claim 1, *Strubbe* recites a system that correlates information about electronic programs (such as pay-per-view movies) and user preferences. (*Abstract*). A database stores information for all or a subset of available "on demand" programs. (*Col. 5, Lines 2-7*). Information from the database about particular programs is presented to a user, and the user indicates whether he or she "likes" or "dislikes" the programs. (*Col. 5, Lines 29-50*). The user's preferences are stored in a second database. (*Col. 5, Lines 7-9 and 51-60*). The second database represents a "mood profile" of the user. (*Col. 6, Lines 39-53*). The first and second databases are used to create a third database, which represents a personalized database containing programs from the first database that strongly correlate to the selections in the second database. (*Col. 5, Lines 61-67*). This process may be repeated, and at any point during this process the user may select a program for viewing. (*Col. 6, Lines 26-32; Figure 4*).

The Office Action asserts that *Strubbe* "fails to disclose ... wherein at least one of the identifiers identifies media content that is not currently, or scheduled to be, available for use." (*Office Action, Page 6, Second paragraph*). The Office Action then asserts that *Girard* "teaches past programming available for use." (*Office Action, Page 6, Second paragraph*).

Girard recites a system for displaying a program guide that includes past, present, and future

programs. (*Abstract*). If a past program is selected, the program is retrieved by a server and provided to the user's set-top box. (*Abstract*). If a present program is selected, the real-time video data stream for that program is provided to the set-top box. (*Abstract*). If a future program is selected, the server retrieves and provides a preview clip of the program. (*Abstract*).

Claim 1 recites displaying "identifiers" and "schedule data" relating to "media content" that is "not currently available for display and not scheduled to be available for display." The databases of *Strubbe* contain information about "available" on demand programs. The system of *Girard* allows a user to select and watch past and present programs, meaning that the past and present programs are currently available for display. The system of *Girard* allows a user to select future programs, which are scheduled for display. The Office Action cites no portion of either reference as disclosing, teaching, or suggesting media content that is "not currently available for display and not scheduled to be available for display."

For these reasons, the Office Action fails to show that *Strubbe* or *Girard* discloses, teaches, or suggests displaying "identifiers" and "schedule data" relating to "media content" that is "not currently available for display and not scheduled to be available for display" as recited in Claim 1. The Office Action does not cite *Williams* as disclosing, teaching, or suggesting these elements of Claim 1. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claim 1 (and its dependent claims).

Claim 8 recites displaying "identifiers" and "schedule data" relating to "media content" that is "not currently available for display and not scheduled to be available for display." Claim 13

recites "identifiers" that identify "programs," at least some of which have content that is "not currently available for display and not scheduled to be available for display." Claim 18 recites "identification data" identifying "media content" that is "not currently available for display and not scheduled to be available for display." Claims 25 and 29 recite a list of "programs" that are "not currently available for display and not scheduled to be available for display." Claim 31 recites at least one identifier identifying "media content" that is "not currently available for display and not scheduled to be available for display."

As described above, the Office Action fails to show that *Strubbe* or *Girard* discloses, teaches, or suggests these elements of Claims 8, 13, 18, 24, 29, and 31. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claims 8, 13, 18, 24, 29, and 31 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1, 2, 4-26, and 29-34.

II. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

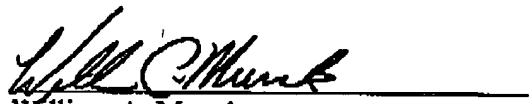
If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Oct. 4, 2004



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